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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,990	03/13/2001	Jin Soo Lee	24286/81651	9375
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SIDLEY AUSTIN LLP 555 CALIFORNIA STREET SUITE 2000 SAN FRANCISCO, CA 94104-1715			EXAMINER SHEPARD, JUSTIN E	
			ART UNIT	PAPER NUMBER
			2424	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/803,990

Applicant(s)

LEE ET AL.

Examiner

Justin E. Shepard

Art Unit

2424

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39, 41-43, 45-48, 50, 51, 53, 54, 56, 57, 60, 62-65 and 67-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39, 41-43, 45-48, 50, 51, 53, 54, 56, 57, 60, 62-65 and 67-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 8/4/08 have been fully considered but they are not persuasive.

Page 10, last paragraph:

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Page 11, paragraph beginning with "But even":

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the html tags

usage would save costs by using a well documented standard instead of creating an all new standard.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39 and 64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims refer to methods with an association with a statutory system or apparatus. The method being implemented on an apparatus without any details of the apparatus does not meet the statutory bar.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 54 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification and the originally filed claims do not include any information regarding a computer readable medium.

Claims 39, 48, 54, and 64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The word distinct could not be found in the applicant's specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 39, 41-43, 45-48, 50, 51, 53, 54, 56, 57, 60, 62-65, 67, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozer in view of Schaffer in view of Chan in view of Toh.

Referring to claim 39, Ozer discloses a method implemented by an apparatus for processing multimedia content and information related to multimedia content consumption (column 4, lines 50-58), the method comprising:

receiving a multimedia program having a program identifier identifying the multimedia program (figure 3, boxes 320 and 330);

receiving content description about the multimedia program, the content description including a plurality of description elements (column 11, lines 47-61);

collecting information about consumption of multimedia content (figure 3, boxes 340 and 350), the collected information identifying a user action related to consumption of content in the multimedia program (figure 4, part 450);

storing a usage history in the apparatus (figure 3, box 350), the usage history including a user action list that is separate and distinct from the content description (figure 4, parts 430, 440, and 450) and includes a user action item (figure 4, part 400) corresponding to the user action (figure 4, part 450), the user action item of the usage history including the program identifier and a link to a specific element of the content description about the multimedia program is located (figure 4, part 430), wherein the specific element of the content description than is related to the content consumed from the multimedia program in relation to the user action and the particular location is separate from the user action list (figure 4).

Ozer does not disclose a method using the link in the user action item of the usage history to generate user preference information including a user preference item and a preference value corresponding to the user preference item, wherein the user preference item corresponds to the specific element of the content description; and wherein the link to a particular location where a specific element is located.

In an analogous art, Schaffer teaches a method using the usage history to generate user preference information including a user preference item and a preference value corresponding to the user preference item, wherein the user preference item

corresponds to the specific element of the content description (column 2, lines 64-66; column 3, lines 13-15; figure 4).

At the time of the invention it would have been obvious to one of ordinary skill in the art to add the user preference corresponding to the content description, as taught by Schaffer, to the system disclosed by Ozer. The motivation would have been to allow the user preference to be updated without requiring a large amount of storage (Schaffer: column 3, lines 4-7).

Ozer and Schaffer do not disclose a method using the link in the user action item to generate user preference information; and wherein the link to a particular location where a specific element is located.

In an analogous art, Chan teaches a method using the link in the user action item to generate user preference information (8, lines 17-21; figures 2A and 2B; Note: as Schaffer discloses a user history with a description field and as Chan teaches adding HTML links to a field of text; the examiner interprets this combination as using the links in the description to create the user action history).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the html file link tags taught by Chan to the method disclosed by Ozer and Schaffer. The motivation would have been to use a known programming language with documented standards to lower development costs by not having to create a new API.

Ozer, Schaffer and Chan do not disclose a method wherein the link to a particular location where a specific element is located.

In an analogous art, Toh teaches a method wherein the link to a particular location where a specific element is located (figure 7).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the html file location tags taught by Toh to the method disclosed by Ozer, Schaffer and Chan. The motivation would have been to use a known programming language with documented standards to lower development costs by not having to create a new API.

Claim 48, 54, and 64 are rejected on the same grounds as claim 39.

Claims 62 and 63 are rejected on the same grounds as claim 39.

Referring to claim 41, Ozer discloses a method of claim 39, wherein the program identifier includes a title of the multimedia program (column 11, lines 53-55).

Claim 65 is rejected on the same grounds as claim 41.

Referring to claim 42, Ozer discloses a method of claim 39, wherein the user action item specifies an action time identifying a time of occurrence for the user action (figure 4, part 410).

Claims 50 and 56 are rejected on the same grounds as claim 42.

Referring to claim 43, Ozer discloses a method of claim 39, wherein the usage history specifies an observation period defining a time period for recording multimedia consumption (column 8, lines 64-65).

Claims 51 and 57 are rejected on the same grounds as claim 43.

Referring to claim 45, Ozer and Schaffer do not disclose a method of claim 39, wherein the link to the particular location is a URL.

In an analogous art, Chan teaches a method of claim 39, wherein the link to the particular location is a URL (column 8, lines 17-21; figures 2A and 2B).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the html file location tags taught by Chan to the method disclosed by Ozer and Schaffer. The motivation would have been to use a known programming language with documented standards to lower development costs by not having to create a new API.

Claims 53 and 67 are rejected on the same grounds as claim 45.

Referring to claim 46, Ozer discloses a method of claim 39, wherein the content description specifies an actor of the multimedia program (figure 4).

Referring to claim 47, Ozer discloses a method of claim 39, wherein the content description specifies a director of the multimedia program (figure 4).

Referring to claim 60, Ozer does not disclose a method of claim 39, further comprising: updating the user preference information based on the usage history.

Schaffer discloses a method of claim 39, further comprising: updating the user preference information based on the usage history (column 2, lines 64-66; column 3, lines 13-15; figure 4).

At the time of the invention it would have been obvious to one of ordinary skill in the art to add the user preference updating taught by Schaffer to the system disclosed by Ozer. The motivation would have been to allow the user preference to be updated without requiring a large amount of storage (Schaffer: column 3, lines 4-7).

Referring to claim 69, Over discloses a method of claim 39, wherein the content description about the multimedia program includes a hierarchy of the plurality of description elements (figure 4).

Claim 68 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozer in view of Schaffer in view of Chan in view of Toh as applied to claim 68 above, and further in view of Osawa.

Referring to claim 68, Ozer, Schaffer, Chan and Toh do not disclose a method of claim 39, wherein the user action includes a replay or a fast forward of a portion of the multimedia program.

In an analogous art, Osawa teaches a method of claim 39, wherein the user action includes a replay or a fast forward of a portion of the multimedia program (figure 4).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the FFD entry in the usage history taught by Osawa to the method disclosed by Ozer, Schaffer, Chan and Toh. The motivation would have been to record more detailed information to the user history, to make the information of more use to advertisers, which would make it more valuable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS

/Annan Q Shang/

Primary Examiner, Art Unit 2424